

**Remarks**

Claims 1, 3-13 are pending.

Claims 1 and 3-13 are rejected under 35 U.S.C. 102(e) as being unpatentable over Ficco (U.S. Pub. No. 2005/0166224 A1).

Applicants respectfully traverse the rejections, and as previously argued, submit that Applicants have provided more than sufficient evidence to antedate the Ficco reference.

**Advisory Action**

The Advisory Action of August 21, 2008 states that Applicants' previous response fails to place the application in condition for allowance. The Action further states that amendments made in the previous response will be entered for the purposes of appeal. The Action also states however, that the affidavit or other evidence filed after a final office action will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not presented earlier. Under the heading "REQUEST FOR CONSIDERATION/OTHER" the Action states that the affidavit is not sufficient to overcome the prior action because the arguments are not convincing.

Applicants made no amendments in the previous response, nor did the Applicants file an evidentiary affidavit. It is unclear from the Advisory Action what the Examiner is referring to by "affidavit." If the Examiner is referring to the Remarks of the Response and Request for Reconsideration, filed July 31, 2008, to be the affidavit, it is unclear if those remarks have been fully considered, as noted in Paragraph 8 of the Advisory Action. If they have not, Applicants respectfully request full consideration of the remarks therein.

**Applicants' Diligence**

The Examiner states that the Applicants' previous response was insufficient to demonstrate diligence on the part of the inventors and its attorneys to file the present application "since they appear to have more than minor interruptions in that they can only seem to account for a few hours of work over several weeks."

Federal Circuit case law, unquestionably, holds that constant effort is not required to show diligence and the inventor need not spend all his time working on the invention. *See Myocen Plant Sciences, Inc. v. Monsanto Co.*, 252 F.3d 1306 (Fed. Cir. 2001) (emphasis added). Applicants respectfully submit that the Examiner's reliance on the activity during a small portion of the critical period of twelve days (sixteen days including weekends) is overly restrictive and unduly burdensome. The evidence shown by the Haberman and Schuler declarations clearly show diligent activity in prosecuting and filing the present application.

The Examiner states the Applicants must account for the *entire period* of time during the critical period in order to show diligence, relying on *Gould v. Schawalow*, 363 F.2d 908, 150 U.S.P.Q. (BNA) 634 (C.C.P.A. 1966). Applicants respectfully submit that the Court's meaning of "entire period" has been misunderstood. In *Gould*, the court found that merely stating that "he [the applicant] took off 6 1/2 days in July, 2 days in August, and 3 days in September" was insufficient to show diligence. *Gould*, 150 U.S.P.Q. at 643. The Court found *Gould's* testimony insufficient to adequately establish *what* *Gould* did and *when* he did it." *Id.* (emphasis in original). The Examiners citation to *Gould*, while correct, is without context as to what is meant by the "entire period." The Court in *Gould* meant that the applicant must show reasonable diligence throughout the entire critical period. The Court clearly did not mean that the applicant

must account for every minute of every day during the critical period. Such a drastic requirement would be unduly burdensome on the applicant and nearly impossible.

Instead, the court stated that, “While reasonable diligence does not require that one abandon his means of livelihood to further his reduction to practice, it was incumbent upon Gould...to establish what was done and when it was done.” *Id.* (emphasis in original). The applicants in this case have done precisely that. Through the inventors’ affidavits, and attorney correspondence and invoices, the Applicants have provided more than sufficient evidence of *what was done and when it was done*. Such a showing is sufficient under Federal Circuit law to show diligence in reduction to practice. Applicants respectfully submit that they, and their attorneys, were diligent throughout the entire critical period.

The Examiner also cites *In re Mulder*, 716 F.2d 1542, 1545, (Fed. Cir. 1983), for the position that “a 2-day period lacking activity has been held to be fatal.” In *Mulder*, however the two day period was the **entire** “critical” period and there was “a total lack of evidence of diligence.” *In re: Mulder* at 1545. For the Examiner to appropriately apply the findings in *Mulder* as analogous to the present matter there would have had to have been a **total lack of activity** during the entire 16 day period. As the Examiner admits, there was significant activity shown during the sixteen day critical period.

Further, even considering the intermittent activity during the sixteen days in question, the Federal Circuit, and its predecessor court the United States Court of Customs and Patent Appeals (“CCPA”), have recognized that it is easier to account for short periods of delay and inactivity. In *Slettinger v. Lincoln*, 410 F.2d 808 (CCPA 1969), an opposing party pointed to a number of short gaps during the critical period, such as a two-day period between execution of the complete patent application and its mailing to the Patent Office. The court held that this gap “of such short

duration” was on of “the inevitable minor interruptions accompanying the conduct of patent prosecution” and fell “within the limits of reasonable diligence.” *Sletzinger* at 812-813.

Accounting for the entire period during which diligence is required does not mean that every second of every day must be spent toward reducing the invention to practice. Such an interpretation is overly narrow and unreasonable to expect of any inventor.

Diligence is proved upon showing that there were no unreasonable gaps over the entire critical period and the inventors have exhibited reasonably continuous activity in filing their application. The five of sixteen days on which the Examiner bases his findings are not nothing more than the inevitable minor interruptions accompanying the conduct of patent prosecution. Clearly the inventors’ and its counsel’s activities fall within the limits of reasonable diligence.

### **CONCLUSION**

For at least the reasons outlined above, Applicant submits that this application is in condition for allowance and requests favorable action in the form of a Notice of Allowance. Please apply any charges or credits to Deposit Account No. 50-1721.

If, in the Examiner’s opinion, a telephonic interview would expedite the favorable prosecution of the present application, the undersigned attorney would welcome the opportunity to discuss any outstanding issues, and to work with the Examiner toward placing the application in condition for allowance.

Respectfully submitted,

Date: February 2, 2009  
Reg. No. 54,146  
Tel. No.: (617) 261-3100  
Fax No.: (617) 261-3175

/George S. Haight IV/  
George S. Haight IV  
Attorney for Applicant(s)  
K&L Gates LLP  
State Street Financial Center  
One Lincoln Street  
Boston, Massachusetts 02111-2950